## REMARKS

In the Office Action, the Examiner is requiring restriction under 35 U.S.C. § 121 to one of the following allegedly independent and distinct inventions:

Group I: Claims 11, 12, and 38-40 allegedly drawn to methods of regulating CTLA-4 T cell interactions and treating immune system diseases with soluble B7/B7 fusion proteins;

Group II: Claims 11, 13, 14, 15, 19, 38, 41, and 42 allegedly drawn to methods of regulating CTLA4 T cell interactions and treating immune system diseases with CTLA4 specific antibodies;

Group III: Claims 11, 15, 16, 19, and 38 allegedly drawn to methods of regulating CTLA4 T cell interactions and treating immune system diseases with CTLA4 fusion protein hybrids; or

Group IV: Claims 11, 15, 17, 19, and 38 allegedly drawn to methods of regulating CTLA4 T cell interactions and treating immune system diseases with CD28/CTLA4 fusion proteins.

The Examiner is also requesting Applicants elect a single disclosed species for prosecution on the merits. The Examiner has identified the following disclosed species:

A) autoimmune disease;
B) allograft rejection;
C) GVHD;
D) allergic reactions;
E) neoplasia; or
F) viral infection (e.g. AIDS, HTLV).

**TRAVERSAL**

Applicants hereby elect the claims of Group I (i.e., claims 11, 12, and 38-40), with traverse. In addition, Applicants elect to prosecute species E (neoplasia) as identified by the Examiner, with traverse. Applicants reserve the right to present additional species upon indication of an allowable generic claim.

Group I is drawn to methods for regulating CTLA4 with soluble B7/ B7 fusion proteins. However, for the record, applicants wish to make clear that the independent claims of Group I, i.e., claims 11 and 38 recite the use of "a ligand for CTLA4". B7 and B7Ig fusion proteins is merely a "species" that fall within that group. A ligand for CTLA4 can also encompass other molecules such as, CTLA4 antibodies (as claimed in claims 13, 14, and 41-42). Accordingly, applicants understand that by electing the invention of Group I, the claims remain directed to methods for regulating CTLA4+ cells using a ligand for CTLA4, but that a species election is being made so that the ligand is B7 or B7Ig fusion proteins. As with any species election, applicants understand that the claims will be restricted to the species if no generic claim is finally held to be allowable.

In addition, Applicants respectfully note that the invention of Group II is drawn to methods of regulating CTLA4 T cell interactions using CTLA4-specific antibodies. For the record, claims 15 and 19 are directed to methods of using B7 ligands. CTLA4 antibodies are not B7 ligands. Therefore, these claims should be removed from this group or the group should be re-characterized.

Further, the invention of Group III is drawn to methods for regulating CTLA4 T cell interactions using CTLA4 fusion protein hybrids. However, claims 11 and 38 are directed to methods using "a ligand for CTLA4", as discussed above. CTLA4 fusion protein hybrids are not "ligands for CTLA4". Accordingly, claims 11 and 38 should be removed from this group.

In paragraph 8 of the Office Action, the Examiner is requiring an election to patentably distinct species of the claimed groups I/II/III/IV. In response, applicants elect neoplasia (species E) with traverse.

Regarding the Restriction Requirement, 37 C.F.R. § 1.142 states that "[i]f two or more independent **and** distinct inventions are claimed in a single application, the examiner ... will require the applicant ... to elect an invention to which the claims will be restricted". In addition, Applicants also point out that under MPEP § 803, there are two criteria for a proper requirement for restriction, namely, (1) the invention must be independent or distinct, **and** (2) there must be serious burden on the Examiner for restriction to be required.

Applicants respectfully contend that the first requirement has not been met because the claims are not independent or distinct. MPEP § 802.01 states that "[t]he term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect." In addition, the Examiner only states that the claims are allegedly "drawn to patentably distinct methods" (March 14, 2001 Office Action, page 1). The Examiner has not stated or provided evidence that the claims are independent as required under 37 C.F.R. § 1.141.

The claims are not directed to independent inventions because they are related in that they are directed to a common effect of a method of regulating CTLA4 positive T cell interactions as the Examiner acknowledges in the grouping of the inventions (March 14, 2001 Office Action, page 1). Therefore, the claims of the invention are not independent.

In addition, the claims are not directed to distinct inventions. The Examiner contends that the various ligands used in the methods of the invention differ with respect to their structure and mode of action (March 14, 2001 Office Action, page 1). Applicants respectfully disagree that the ligands differ in their mode of action. The ligands commonly regulate CTLA4 positive T cell interactions by interfering with the interaction of CTLA4 positive cells with B7 positive cells. The claims simply refer to this mode of action. Thus, the claims of the invention are not distinct. Accordingly, the criteria for requiring restriction has not been met.

Further, the second requirement of § 803 has not been met because the Patent Office has not demonstrated a serious burden for searching the art. In that regard, the Examiner has indicated that the claims of Groups I, III, and IV are all classified in Class 424, subclass 192.1. The fact that the claims of Groups I, III, and IV are in the same class indicate that a search of the art would

not place an undue burden on the Examiner. Moreover, separate prosecution of these claims would be unnecessarily duplicative and thus wasteful of Patent Office resources. Therefore, under MPEP § 803, the instant claims do not require restriction.

## CONCLUSION

Applicants submit that claims 11-19 and 38-42 should properly be examined together for the reasons discussed above, and respectfully request the Examiner reconsider and withdraw the Restriction Requirement.

No fee, other than the extension fee, is deemed necessary in connection with the filing of this response. If any fee is necessary, the Patent Office is authorized to charge any additional fee to Deposit Account No. 50-0306.

Respectfully submitted,

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